

No. 55.

IN THE

UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT.

CONSOLIDATED PIEDMONT CABLE COMPANY,
APPELLANT,
vs.

PACIFIC CABLE RAILWAY COMPANY,
APPELLEE.

APPELLANT'S PETITION FOR A REHEARING.

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The patent sued on in this case describes an apparatus for taking up the slack of the cables which are in common use in street cable railroads. The apparatus is a little peculiar, and, according to the evidence, contains devices which are not at all necessary. The apparatus described in the patent has at its upper part an ordinary pulley-wheel car, which carries the ordinary pulley around which the main cable of the road runs. These main cables stretch from use to a considerable extent, and they also change their length on account of the changes of temperature which are constantly occurring.

On account of this changing of its length and this stretching of the cable, some kind of apparatus has always been in every cable railroad that has ever been built, by means of which the cable would be kept taught all of the time, so that the requisite amount of friction would be obtained to keep the cable running and prevent it from slipping around the driving cable pulleys.

It is well known that San Francisco can boast of having built the first cable road having the cable running under ground that ever was built, and that that road commenced running for regular business in September, 1873.

In 1881 the patentee Henry Root made application for the patent sued on and it was granted to him July 12th, 1881. The patent explains that the patentee has invented an *improved* tension apparatus for cable railways. It does not pretend to assert that it was the first tension apparatus used for that purpose.

The apparatus described as this improved tension apparatus begins at the upper part with the main cable pulley around which a bite of the main cable runs. In order to keep the cable taught and allow it to go and come as it lengthens or shortens from heat and cold it was of course necessary that the main cable pulley mentioned should have some freedom of action to move along the line of cable in both directions. Naturally therefore it was mounted upon a truck or car so that it could be furnished the necessary freedom of motion. Being mounted upon a car for the purpose of having traveling motion lengthwise with the main line of the cable it was natural that tracks of some kind should be furnished for the cable car to move on. In order to keep the cable taught there was a weight hung to the end of a chain which passed over a chain pulley and which chain had its other end attached to the cable pulley car so the weight would always pull against the pull of the cable in the opposite direction, just as the heavy hammer of a pile driver, when it happens to be hoisted part of its distance upward and there held stationary as often happens—hangs pulling against the power which holds it from coming downwards.

All that was needed in the tension apparatus to make the weight effective was a single chain or rope pulley fixed near the fartherest limit to which it was desired that the cable pulley car might travel along its track as the rope stretched, and then fastening one end of the chain to the cable pulley car and then pass the chain or rope over the stationary chain pulley mentioned and suspend the weight by it. The only objection to this method was that the chain would have to be very long and the well or pit down which the weight would go must be correspondingly deep. This difficulty could be easily overcome in two ways. One easy method would be to make the weight chain or rope short and connect its upper end with the pulley car by an ordinary tackle or pulley blocks similar to that shown in the patent, and then, whenever the weight got too near the bottom of the pit, pull in the line of the tackle and by so doing raise the weight as far as desired. The other easy method would be to put a drum on to the pulley car and fasten the upper end of the long chain or rope—a rope cable answers the same purpose as a chain—to the drum and when the weight lowered too far draw it up again by turning the drum and winding up the cable just as the weight of a pile driver is raised by running its rope over a high pulley

above it and winding the other end of its rope around a drum and thereby raising it to any desired elevation.

Mr. Eppselheimer had taken out a patent—Exhibit I of the record—which had such a drum and rope, *but which being devices so well known for similar purposes the patent did not undertake to cover them by its claims.* The patent had other devices which were intended to operate and raise the weight automatically. Whether these automatically operating devices of the Eppselheimer patent were of any practical value or not is of no consequence to this case since they are not covered by the complainant's patent, nor are they used by the defendant. But that the drum and weight and weight pulley were good practicable devices for raising and holding the weight, no one who has ever seen an ordinary derrick or pile driver operate can have any doubt. Mr. Bell testifies very fully that they were practicable and he is not contradicted in this (see Trans., pages 26 to 32 and 34 and 35), and there is no contradictory testimony to his statement in this respect, and if there was the Court would know that it could not be true.

The patentee, however, chose to get up a different apparatus and obtain his patent for it. Whether it has any advantages over the more simple methods or not is not shown. We are unable to see any such advantages and we have never heard of any.

The patentee after contriving to have a cable pulley car upon one set of tracks also contrives a secondary set of tracks and builds up a sort of car without any wheels which is to slide upon these secondary tracks. He makes his claims so as to include as a part of his invention *both* these first *and* secondary tracks.

In the Eppselheimer patent the frame C, mounted on the rollers D, constitutes the cable pulley car. This car runs on a track and carries the main cable pulley. It has a drum that winds up the weight rope so as to shorten it when the weight gets too near the bottom of the pit. It also has a pawl O, attached to the frame C (This frame C is the car body). This pawl O will drop down into the rack N, which is a part of the track so as to prevent the car from being pulled forward after the weight has drawn it backward and thus taken up some of the slack of the main cable. This is exactly the same combination as that of the hook pawls L, which engage the teeth of the racks K, and hold the frame I, in place in the Root patent sued on. Every ultimate result

that can be obtained from the combinations of the patent sued on are obtained by the combinations of this prior Eppelsheimer patent.

In now referring to the Eppelsheimer patent we leave out all of the automatic part by which the weight was to be wound up by the action of the apparatus itself. That is the part which the witness Bell says "would entail complications." It is true that Bell also says that he would use the block and tackle instead of the drum of the Eppelsheimer patent, but he does not for a moment pretend or assert the drum is not perfectly practicable.

Now this Eppelsheimer patent states, and itself describes, two methods which had already been in prior use for taking up the slack of the cable. One of these methods was by the use of a weight attached to a frame that was either sliding or mounted on wheels which carried the rope or chain pulley. The other was by the use of the block or screw. The block is the common expression by which the block and tackle are designated, so that when Bell said he preferred the block and tackle to the Eppelsheimer drum he still was not preferring anything that was not mentioned in this same Eppelsheimer patent. Now Eppelsheimer was the constructing engineer of the Clay Street Cable Road which was the first cable road ever built. He was building cable roads many years before Mr. Root came into the field at all and he knew when he applied for his patent what he was saying, and what had been in use before for taking up the slack of the cable.

But the patent of Mr. Root sued on also tells that there had already been a usual method of taking up the slack of the cables before he came into the field with his alleged invention. The patent says:

"The *usual* method for keeping a tension upon the cable "is to pass it around large pulleys at one or both ends, and "these pulleys are mounted upon trucks. A chain passes "from the rear end of the truck over a stationary pulley, and is "attached to a heavy weight within a pit, *and this produces* "the required tension. The cable soon stretches, however, so "that the greatest depth of pit which can be conveniently "used within a roadway is insufficient for the sinking of the "weight, and the cable must be taken up either by removing "a portion or by taking one or more turns around the drum "or pulley. This process must soon be repeated, and causes "considerable delay and inconvenience."

Now, all that the patent provides for is the taking up of the slack by shortening the connection between the weight and the cable pulley car. The Eppelsheimer patent *did this same thing*. There is not a single result obtained by the patent sued on that was not obtained by the Eppelsheimer patent. Not a single one. We challenge the world to point out a single one. We mean, of course, any ultimate useful result, and not merely the immaterial differences that result between the use of the drum and the pulley block and tackle. It may be said that one result in the Eppelsheimer is the winding up of a drum, while in the Root there is not that particular result, because no drum is used, but a block and tackle instead. We do not mean such immaterial, internal minor results; but we do mean every single one of the general ultimate results which were sought for by the application of any and all the means used by all the cable roads. In all the cases a car was used that carried the main cable pulley. In all the cases that car, either by sliding or rolling on wheels, traveled on a track that ran lengthwise with the main cable. In all cases the amount of slack that could be taken up could be just twice the distance that this car that carried the main cable pulley was allowed a track to move along. As there was a double line of the cable, one coming in one direction and the other going back in the opposite direction, when the cable stretched two feet the pulley car moving one foot along the track would take up that two feet of slack, as it would take up a foot of slack on each one of the two lines of the cable. In all cases the weight was attached to one end of the rope or chain that passed over a pulley while the other end of the rope or chain was fastened to the car that carried the cable pulley. In the Eppelsheimer patent there were the pawl and rack to keep the cable car from being pulled forward by the cable just as there was in the Root patent, and in the Eppelsheimer patent there were the means for shortening the rope or chain connection between the cable car and the weight so as to keep the weight from striking the bottom of the pit in which it was suspended.

Now, while this Court would, according to its precedents, hold the apparatus of the Eppelsheimer patent to be a villainous piracy and infringement of the Root patent, if it had only been later, it looks at it in altogether a different light when it is shown to be of prior date and an anticipation of all the useful results obtained by Root.

The particular point we are endeavoring to force upon the comprehension of the Court is this: That the *principle* of a machine already existing does not belong to the inventor of an *improvement* thereon, any further than his improvement creates a *new* principle, and then no further than his *claims cover* such devices or combination as works out some new principle of mechanical operation that did not exist in the original machine or apparatus to which the improvement was added. We are endeavoring to illustrate this principle of patent law by the Eppelsheimer patent, by showing that the same general principle of operation was included in that. By this we have some faint hope that the Court will, by comparing the Eppelsheimer patent with the Root patent, come to a realization of the fact that the same mechanical principle or mode of operation cannot belong to both of the patentees, and that whatever there was of mechanical operation in the first patented apparatus must be subtracted from the mechanical operation of the second patent before it can be decided what new mode of operation, if any, was developed by the improvement claimed. Certainly Root did not invent what he already knew had been made by others. He *learned* those things. He *did not invent* them. Not only was the Eppelsheimer patent ahead of him, but he states in his own patent what the usual method was for obtaining the necessary tension upon the cable, and that method was to mount the main cable pulley upon a truck the same as he does; also to pass a chain from the rear end of the truck over a stationary pulley, and have it attached to a heavy weight within a pit, and he says in his patent "THIS PRODUCES THE NECESSARY TENSION."

Now here we have the fact stated by the patentee himself in the very patent sued on that the old apparatus did produce the necessary tension. It was not he therefore who first produced the necessary tension. All others needing the tension had already done this before he began.

Not only had others already produced the necessary tension but they had produced it by the very suspended weight which he used. The application of the suspended weight over a pulley so that it pulled counter to the main cable was the method already in use and includes the general mode of operation which Mr. Root uses and obtains by his apparatus. Now where does the old method and its principle of operation stop, and where does any new mode of operation begin that is produced by the alleged improvement, leaving out for the

present the Eppelsheimer apparatus and considering only the things that the patentee himself says were in the usual method. We think that all that can be picked out of new operation between the new apparatus that is in the Root patent and this old usual method spoken of in the patent is the shortening of the connection between the cable pulley car and the weight so as to keep the weight from reaching the bottom of the pit when the cable lengthened.

Now we concede that this was so much of a new general operation, and if Mr. Root was the originator of that operation that he could claim that much of the principal of his apparatus. Unfortunately for his patent, however, this method of shortening the connection between the cable pulley car and the weight was not new with Mr. Root because it was in the Eppelsheimer apparatus, to which we have already referred. We do not refer to the automatic part of that apparatus the utility of which may be claimed to be doubtful, but we refer to the drum for winding up the rope that connects the weight with the cable pulley car. This was entirely practicable, as much so as any derrick or pile driver that ever was made. Mr. Bell testifies to its practicability and he is not contradicted in any way, shape or manner. This shortening of the connection between the cable pulley car and the tension weight was therefore no part of the patentee's new operation. That principle of mechanical operation he got from Eppelsheimer.

Now, after subtracting the operation of the suspension weight and the operation of shortening the connection between the cable pulley car and the weight, what in the way of mechanical operation, or method of operation, or principle of operation is there left? There is a difference in the devices used for performing the operation we admit, but now we are only talking about the mode of operation of the combinations of devices. We are not talking about the devices by which the operations are performed. The Court in its decision has said, in comparing the patented combination with the defendants: "*The purpose, principle and operation of the machines are the same, and the defendant's escapes exact similitude of construction to the plaintiff's only by a few alterations.*" May not the same thing be said in comparing the Root with the Eppelsheimer. Was not "*the purpose, principle and operation of*" Root's machine "*the same*" as Eppelsheimer's, and did not Root's escape exact similitude of construction with Eppels-

heimer only by a few alterations? Obviously this is so. The purpose is exactly the same. The operation of suspending the weight by a rope or chain over a pulley was exactly the same, and the shortening of that rope or chain when required was done by equivalent means in both cases, and the result of keeping the weight from reaching the bottom of the pit so as to keep up the tension on the main cable was exactly the same, in both cases, and in neither case was any other ultimate result produced. We ask the Court to seriously study this proposition and find if it can any ultimate result that was obtained by Root that had not already been obtained by Eppelsheimer? Of course, there was none. A perfectly good and sufficient tension apparatus had been obtained for every cable road built, and in nearly every instance it was obtained by the counter weight, etc., which Mr. Root describes as the usual method in his patent.

We believe that this Court is desirous of making decisions that are in conformity with law and justice. But will the Court never find out that when it gives the mechanical operation, or principle of operation, or the purpose accomplished to an inventor who did *not discover or invent* either such mode or principle of operation, or such purpose or object as was accomplished by the mechanism used, *but not by the patented improvement made*, that it is perpetrating the grossest injustice; that it is in solemn truth robbing the defendants and giving what is their own to those who have no right, title or equity thereto.

We are making this effort more for the purpose of setting the Court right on the interpretation of patents than because we care for this case. The case itself is of but trifling importance. If the injunction is made perpetual, it would not take much over two hours to change the defendants tension so that there could be no pretence of infringement on any body's patent, and any damages that could be proven would not amount to enough to pay for fighting for them.

Now we do ask the Court to take this case and find by candid consideration where the old methods of operation, including Eppelsheimer's apparatus, stopped, and where any new operation, or new purpose, or new object accomplished by Mr. Root, commenced. If it will do this in this case it will have reached a method of interpreting patents that other courts have long ago reached. It will have found a method of being able to give to the parties in a patent case the actual rights

that belongs to each, and by so doing will reach an era that will put it on a plane with other courts. It will then be prepared to understand the reasoning and the decisions of the U. S. Supreme Court and of the Eastern courts generally. In deciding questions as to damages in patent cases the Court has no considerable trouble, but as soon as it strikes at the construction of a patent or the questions of what is or is not an infringement its decisions are so uncertain to say the least that there is not a patent lawyer on this coast who can give any client in ordinary cases any reliable advice as to what judgment will probably be rendered in any patent case in which he may be concerned. No attorney dare advise a client that judgment will not be rendered against him notwithstanding that both the client and attorney know that there is no infringement. This uncertainty comes from the fact that the Court will not separate what the patentee has invented from what he did not invent and then give to him just what belongs to him, no more and no less. There has been issued by The West Coast Publishing Co., one volume of the decisions of the new Courts of Appeal. In that volume are some thirteen decisions in patent cases. Among them is the case of *Norton vs. Jensen*, decided by this Court. It makes very strange reading when compared with the other decisions rendered by the other Circuit Courts of Appeal. That decision is a striking example of the utter ruin and desolation to the country at large, as well as to the parties litigant, that an erroneous decision can make. In that case Jensen had invented a new machine that headed filled fish cans in a vertical position, Norton had made no such invention but had patents on other kinds of can heading machines. This Court held that although the Norton machines would not do the same kind of work that the Jensen machine did, that there was the same principle, etc., etc., etc., and affirmed a decree against the Jensen Company. The consequence is that the public are deprived of the use of any machine for doing that kind of work. It must not use Jensen's because of the injunction and it cannot use Norton's because Norton has none that will do that kind of work. Besides Jensen is financially ruined for no other fault than because he made a valuable invention and made a very ingenious machine, and one that, according to the law which the other circuit courts of appeals have been declaring would be no more an infringement of the Norton patents than a rail fence would be an infringement of a hedge hog. The

devices in Jensens machine were different, its combinations were different, its mode of operation was different, its entire plan of construction from beginning to end was different, and the kind of work that it did was different from any thing that any or all of the Norton patented machines could be made to do. These differences of devices, combinations and mode of operation and entire plan of the machine had to be different from Norton's in order to do the new work which Jensen's machine was made to do and which it did do, and which the none of the Norton machines ever did do or ever can do. The consequence of that decision is the shutting up of Jensen's factory, the putting out of use his machine with nothing else to take its place, ruin to Jensen, and great loss to the public. That decision is published in connection with the decisions of the other courts of appeal, and there it looms up in conspicuous but lonely isolation so far as its declarations of law are concerned. It is very lengthy and in this first volume towers as a huge monument of the interpretation of patent law on the Pacific Coast. In its conspicuous eminence can we point to it in the future with pride, or will its mention be answered only by humiliating pangs. We hope that we have said enough to enlist the earnest desire of the Court to so interpret patents that each inventor shall be given to him just what he has invented and covered by his claims, and nothing more and nothing less. We trust that we have made the Court realize and feel that by giving just such an interpretation to patents it will be doing exact justice in all cases because it will be giving to each party just what belongs to it, and will not be taking from one party what belongs to him and giving it to another who has no right to it. Hoping that we have succeeded in doing this we will go a step further and venture to remind the Court that in the long history of patent litigation other courts have been doing the same thing, and that they have discovered and applied some unvarying rules to some classes of patents and patent claims which have been found efficacious in reaching the highest degree of just results and have therefore been adopted as settled rules, which attorneys may rely upon in giving counsel to their clients, and which parties also may depend upon when bringing or defending patent suits.

One of the most unvarying as well as the most important of all of these rules is that with regard to claims for combinations. The great majority of patent claims are combination claims. For this reason the settled rules for the construction of claims

for combinations are the most important rules of patent law, because they are of the most universal application of any rules belonging to this branch of the law.

No one of these rules is better settled than the one which declares that a claim for the combination is not infringed unless every mechanical element that is named by the claim as one of the elements of the combination can be found in the defendant's machine. We will not quote authorities here, but refer the Court to our original brief for them, as well as for authorities upon other points made. We do not wish to repeat here the things already said in the brief filed on the hearing of the case, but we ask the Court to read that brief with this petition.

We will now return to the patents of Eppelsheimer and Root, and again inquire what there was of minor detail operation and change of construction between the Eppelsheimer apparatus and the later one of Mr. Root.

In Eppelsheimer's, the weight pulley was stationary and the drum for shortening the weight rope was on the same car that carried the main cable pulley, while in Mr. Root's he placed a sliding car under the main cable pulley car and fixed his weight pulley on to this sliding car. He shortened the suspended end of this rope by pulling the sliding car away backwards underneath the cable pulley car. In this respect he differed from the prior apparatus, and from Eppelsheimer.

The defendant uses two cars as does Mr. Root. It, however, puts them both on the same level and on the same track, while Mr. Root employs an upper track for one car and a lower track for the sliding car. Defendant shortens its rope connection between the weight and pulley car by drawing its second car back from the cable pulley car, and in this respect it adopts an operation that was used by Mr. Root with his sliding car and which was not used by Eppelsheimer, nor so far as the evidence shows, was it used by any one until Mr. Root used it. We think we have now stated what was new in Mr. Root's apparatus, and how much of it was used by the defendant, quite as fully as the Court will think it ought to be stated.

Now if Mr. Root had obtained his patent for the combination of this second car carrying the weight pulley and being drawn back as described in the patent with the pulley car without putting other elements into the combination which the defendant does not use, the defendant's would be infringers,

because in the use of two cars merely the defendant's is like Mr. Root's. But it was Mr. Root's duty to claim all that he asserted to be his invention, and it was the duty of the patent office to give him all that he had invented. If, however, he did not claim all that he was entitled to claim, or if he made such claim and accepted the patent with a more limited claim because the office would not give him more, then he can hold only what the claims of his patent cover. Under any and all circumstances when a patentee brings suit upon his patent he is bound by the claims of his patent.

Leggett vs. Avery, 101 U. S., 256.

Shepard vs. Carrigan, 116 U. S., 593.

Fay vs. Bordesman, 109 U. S., 403.

Goodyear Dental Vulcanite Co. vs. Davis, 102 U. S., 222.

Mahn vs. Harwood, 112 U. S., 354.

Cartridge Co. vs. Cartridge Co., 112 U. S., 624.

Sargeant vs. Hall Safe and Lock Co., 114 U. S., 63.

McClain vs. Ortinayer,

Keystone Bridge Co. vs. Phoenix Iron Co., 95 U. S., page 278 and cases there cited.

In the construction of his apparatus Mr. Root did not choose to use two cars upon the same track. For reasons best known to himself he preferred to have the sliding car made long and placed underneath the cable pulley car in such a manner that he *must use two tracks* instead of using only one track. Neither this Court, nor Mr. Root, or any one else, can use the sliding car underneath the pulley car and have them move, one over and one underneath the other, without using the *two tracks*. This would be a physical impossibility. Now the evidence shows that the lower track must be just as long when the upper track is used with the sliding car as it is when it is used with the two cars as the defendant uses it. (Record, page 16.)

On the other hand, if Mr. Root had put his sliding car and cable pulley car on the same level and on the same track he could not have used the upper track or timbers E, at all. Between the apparatus of Mr. Root and that of the defendant's there are the tracks or timbers E. In Root's case the timbers E, or some equivalent of them, are *required*, and *are used* for carrying the upper car which carries the cable pulley. In the defendant's apparatus there is no upper car and there is

no place to apply tracks or timbers for such upper car to run on, and there are no such timber tracks or timbers, nor any equivalent of them. In the defendant's apparatus such upper tracks *are not used and cannot be used*. The defendant's apparatus uses for its two cars only the lower track, and it uses only the same amount of such lower track for both its cars as Root's apparatus uses for his sliding car.

Now, we ask the Court to look at this matter *as it is*, and to say whether we have told the exact truth in the foregoing statement or not. We know that we have, and the defendant's officers know that the above statements are true to the very letter. And if the Court still thinks that they are not true, will the Court inform us by some definite description *how it could use* the upper tracks E, or any equivalent of them, in the defendant's apparatus. Where would the Court place them, or any equivalent of them, in the defendant's apparatus? *What service could the Court find for them or for any equivalent of them to perform?* What could it make them do? Certainly, if the Court can find those upper tracks E in the defendant's apparatus it can tell us where they are and what services they are performing. The cold matter of fact is that the defendant does not have those upper tracks, nor any equivalent of them, nor does it have any place to put them, nor could it use them with both its cars running on the lower tracks if it wanted to. The Court has not found them there, nor can it find them in the defendant's apparatus.

To illustrate a little further, we will suppose that Eppelsheimer's apparatus was exactly like the defendant's, in every detail of construction and operation and combination. Would not Mr. Root's patent be just as good then as it is now? He would be subsequent to Eppelsheimer, but he would still put in his sliding car underneath the pulley car, just exactly as he has done now. *He could still make his claims just exactly as he has made them now, and the Eppelsheimer apparatus would not anticipate a single one of those claims.* In other words, if the defendant's apparatus was much older than Root's improvement—supposing it to be an improvement—there would not be a feature of it that would have prevented Mr. Root from obtaining exactly the same patent with exactly the same claims that he now has. *The upper track E is one of the elements of each one of Root's claims. The track E is not in the defendant's apparatus.* Each of Mr. Root's claims are combination claims only. Being combination claims, and not

claiming any of the elements by themselves, they *per se* admit that all of the elements of each claim, and every imaginable combination of all of those elements, less any one of them, was old, and no part of the patented invention. The upper track E being a new element, that is not in the defendant's apparatus, it would not have been any anticipation of Mr. Root's patent if defendant's apparatus had been prior to it.

We now turn to the opinion which the Court has rendered in this case, and see whether the Court itself has not agreed with our facts of the case. The opinion says, on the question of infringement:

“ The plaintiffs claim the invention to be a cable pulley “ having its axis journaled upon a car which moves on rails “ or timbers, which again travel on a second track. It is “ called in the patent a secondary track. In the defendant's “ device *part of the rails and timbers which appear in the “ plaintiff's device are cut away*, and the movable car which “ supports the cable pulley and upon which it is journaled, as “ in plaintiff's patent, is let down so that the car which carries “ the cable wheel and the car—(if it can be called a car— “ in the plaintiff's patent the name is ‘ rails or timbers ’) which “ carries the chain wheel *moves on the same track*. This change “ involves minor alterations, which are not necessary to detail.”

Now, in this, the Court agrees with us that the upper “ rails or timbers ” which appear in the plaintiff's patent, and which are elements in each one of the claims, “ *are cut away*,” and the *pulley car is let down upon the lower track*. The upper track is therefore entirely dispensed with in the defendant's machine. The Court after thus stating in effect that those upper tracks or rails E were not in the defendant's apparatus immediately shuts its eyes to the rule of law which declares that if the plaintiff's claims are for combinations, and if there is one of the elements included in each of those combinations which is not in the defendant's machine, that there is no infringement. (See our original brief, page 13, for authorities on this rule.) The plaintiff's claims are two in number and both of them are combination claims, and both of them include, as a part of each one of the combinations which they cover, these upper rails E which the defendants do not use. The first claim includes the cable pulley upon the movable car C, and the chains F and weight H, “ *in combination with the rails or timbers E upon which the car travels*, mounted upon

a frame, I, which moves upon a secondary track, J," etc. The second claim claims: "The Car C, moving upon the rails E and supporting the cable pulley A, the weight H, and chain F, and the rails E, moving upon a secondary tramway J, in combination with the operating tackle and the holding racks and pawls," etc.

We repeat that in each of these claims the upper tracks or timbers E are made elements of the combination that is covered by the claim. We repeat that those timbers or any equivalent of them are not to be found in the defendant's apparatus, and the Court has not found them there and in its opinion fairly states that they are not there. Yet as soon as the Court makes this declaration it immediately leaps over the rule of law above mentioned which applies and controls just such combination claims, and lights with both feet upon the defendant and says it does infringe. The law says if one element is left out of the combination that the defendants do not infringe. The Court says that the defendants have left out one of the elements of the combination yet that they do infringe.

Now, we ask the Court to say directly whether those upper rails are not an element in both the combinations claimed by the patent, and whether the defendant's apparatus has not left those upper rails or timbers out of its apparatus, and whether it has not kept outside of the plaintiff's claims by so leaving out those upper tracks or timbers?

We trust that we have succeeded in showing to the Court that "the purpose, principle and operation" of Root's machine was already in the prior Eppelsheimer patent, and that Root did not invent or discover any part of that "purpose" or "principle" or "operation," and that therefore none of that "purpose," or "principle" or "operation" belonged to him, and we hope that the Court will begin now to apply to the interpretation of patents the rules of law which the text writers apply, which the Supreme Court applies, and which all other courts, except those of this coast, have always applied; rules which must be applied if justice is ever to be done. We again ask that it will now apply to the combination claims of the plaintiff's patent in this case the one rule so thoroughly established which is, that as the patent claims only combinations which specify certain elements and that as the defendants do not employ one of those specified elements nor any equivalent of it, but so construct their apparatus that it *dispenses with*

both the element and with the service which it performs that there can be no infringement, and also that the Court will begin now to refuse to give to a patentee the "purpose" or "principle" or "operation" of a machine when it is clearly and distinctly shown that such patentee did not discover, or invent, or develop any part of that "purpose," or "principle" or "operation," but only took all those things as he already found them and applied thereto his improvements or inventions whatever they might be.

The Court says in its opinion that: "It is not a case of using the elements of a combination less than all. It is a case of using the same number of elements and altering the form of one, and not materially altering the relation of any to the others."

What in the world can the Court mean by this sentence? Is not that upper track E an element in each of the combinations claimed? Will the Court deny that it is so in the face of each one of the claims which makes it an element as plainly as language is capable of doing it? In the defendant's apparatus is not that upper track left entirely out and nothing supplied in its place? Will the Court pretend to deny this fact? If these things are so, then why is it not a case of using less than all the elements of a combination? And if that element is left entirely out and nothing put in its place, how in the world can the Court say that the defendants are using the same number of elements? Again, to what can the Court refer when it says that the form of one element is changed by the defendant? The lower tracks J remain the same, and surely they are not altered. The upper tracks are left entirely out and they are not altered. They are not made in any form, not even looked at or touched by the defendant. If the Court refers to them as the element that is changed in form, pray tell us what its new form is.

While the sentence above quoted from the opinion of the Court is easily written, its effect is not so easy to bear. Unless this Court changes its method of deciding patent cases the only safe thing for the manufacturing public of this coast to do is to shut up their shops. Within the last two days a case has occurred in which the Rolling Mills in San Francisco was afraid to bid upon a job for fear that the Circuit Court here would hold it in contempt, although the rails to be rolled would not, according to ordinary construction of patents, come any where near being any infringement of the patent on

which a suit had been brought in this Court. We refer to the case in which His Honor Judge Sawyer rendered a decision from the bench in favor of an Eastern complainant, but before signing the interlocutory decree concluded that he had made a mistake and voluntarily requested the defendant's counsel to file a petition for a rehearing, which was done. Before Judge Sawyer acted on the petition he died, and the matter came up before his Honor Judge Hawley. Against our remonstrance Judge Hawley signed the interlocutory decree on, and because of, Judge Sawyer's decision. The petition for a rehearing was also before him, but after holding it under advisement until our time for appealing from the interlocutory decree had passed he refused to consider the merits of the petition and denied it upon the ground, as we understood him, that he would not overrule Judge Sawyer's decision. The consequence is that an injunction stands against the Rolling Mills, and it was obtained in the first instance by stretching the patent away beyond the calls of its claims, and on account of such stretching of the claims of the patent the Rolling Mills officers are unable to judge, and as their counsel we are equally unable to advise them, as to what the Circuit Court will not hold to be an infringement. Already on account of that decision, which would never have been made by any one of the Eastern courts, or by the U. S. Supreme Court, there is that much of the business that legitimately belongs here transferred to the East.

Respectfully submitted.

M. A. WHEATON,
I. M. KALLOCH,
F. J. KIERCE,
Counsel for Appellant.

We, the undersigned, hereby certify that we are counsel for the appellant in the foregoing entitled cause, and that we have prepared the foregoing petition for a rehearing therein; we further certify that, in our opinion and judgment, the said petition is well founded in law and is proper to be filed in said cause.

M. A. WHEATON,
I. M. KALLOCH,
F. J. KIERCE,
Counsel for said Appellant.

